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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,250	03/17/2004	Isidor Hazan	FA1165USNA	5975
23906 7590 12/06/2007 E I DU PONT DE NEMOURS AND COMPANY LEGAL PATENT RECORDS CENTER BARLEY MILL PLAZA 25/1128 4417 LANCASTER PIKE WILMINGTON, DE 19805			EXAMINER NILAND, PATRICK DENNIS	
			ART UNIT 1796	PAPER NUMBER
			NOTIFICATION DATE 12/06/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-Legal.PRC@usa.dupont.com

Office Action Summary

Application No.

10/803,250

Applicant(s)

HAZAN ET AL.

Examiner

Patrick D. Niland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11/06.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application
- ☐ Other: ____.

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1. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The term "low molecular weight" in claims 1 and 12 is a relative term which renders the claim indefinite. The term "low molecular weight" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear what the intended scope of "low molecular weight" is.

B. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 1 and 12 recite the broad recitation "silane functional compound with a hydrolysable group on the silane group", and the claims also recite "and preferably at least one additional functional group" which is the narrower statement of the range/limitation.

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C. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 1 and 12 recite the broad recitation "silane functional compound with a hydrolysable group on the silane group and preferably at least one additional functional group", and the claims also recite "(urea, urethane and/or hydroxyl)" which is the narrower statement of the range/limitation.

D. Claims 1 and 12 recite "silane functional compound with a hydrolysable group on the silane group and preferably at least one additional functional group (urea, urethane and/or hydroxyl)". It is unclear from this claim format if the additional functional group must be one from the list "(urea, urethane and/or hydroxyl)" or if any other functional group is encompassed.

E. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and

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Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 13 recites the broad recitation "molded SMC and other plastic parts", and the claim also recites "particularl auto parts" which is the narrower statement of the range/limitation.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 11/332064. Although the conflicting claims are not identical, they are not patentably distinct

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from each other because, although the claims differ somewhat in scope, they overlap to such an extent that the ordinary skilled artisan in practicing the copending claims would necessarily infringe the instant claims and vice versa. It would have at least been obvious to the ordinary skilled artisan to practice the instantly claimed inventions from the claims of the copending application due to this large scope overlap.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 5-6, and 8-16 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5250605 Hazan et al..

Hazan discloses a composition which can be used as a primer surfacer containing the instantly claimed ingredients in the instantly claimed amounts at the abstract; column 2, lines 60-68; column 3, lines 1-68, particularly 4-26, 32-55, 48 of which 45-55 encompasses the amounts of the instantly claimed component (a) and the amounts of the instant claims 3 when coupled with pigment amounts, and claim 11, 49-55, which broadly encompasses component (a), 56-61 which

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falls within the scope of "low molecular weight" of component (a); column 4, lines 1-68, particularly 35-68 which falls within the scope of the claimed "silane functional compound with hydrolysable groups"; column 5, lines 1-68, particularly the formula of line 45 which falls within the scope of the urethane functional group of component (a) and the low molecular weight polymer of this section also falls within the scope of the instant claim 6; column 6, lines 1-68, particularly 35-44 which also falls within the scope of the instant claim 6; column 9, lines 1-68, particularly 8-68; column 10, lines 1-68; column 11, lines 1-68, particularly 52-68 and column 12, lines 1-68, particularly 39-50, which falls within the scope of the instantly claimed component (f) of claim 12; column 13, lines 1-68, particularly 30-56 which falls within the scope of the instantly claimed component d and its amount; column 14, lines 1-68; column 15, lines 1-68, particularly 32-43 which is its use as primer surfacer on plastic substrates, which encompasses the instantly claimed 13-16 since claim 16 recites no structure and thereby encompasses the substrates of the patentee which are useful in some capacity in an automotive body panel as they are assumed to be sheets, lines 44-55 of which carbon black and metallic flake pigments are the conductive pigments of the instant claim 5, and lines 65-68; column 16, lines 1-68, particularly 1-6; column 17, lines 1-68, particularly 1-10; and the remainder of the document.

7. Claims 1-6 and 8-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5250605 Hazan et al. in view of US Pat. No. 5413809 Hazan.

Hazan discloses a composition which can be used as a primer surfacer containing the instantly claimed ingredients in the instantly claimed amounts at the abstract; column 2, lines 60-68; column 3, lines 1-68, particularly 4-26, 32-55, 48 of which 45-55 encompasses the amounts of

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the instantly claimed component (a) and the amounts of the instant claims 3 when coupled with pigment amounts, and claim 11, 49-55, which broadly encompasses component (a), 56-61 which falls within the scope of "low molecular weight" of component (a); column 4, lines 1-68, particularly 35-68 which falls within the scope of the claimed "silane functional compound with hydrolysable groups"; column 5, lines 1-68, particularly the formula of line 45 which falls within the scope of the urethane functional group of component (a) and the low molecular weight polymer of this section also falls within the scope of the instant claim 6; column 6, lines 1-68, particularly 35-44 which also falls within the scope of the instant claim 6; column 9, lines 1-68, particularly 8-68; column 10, lines 1-68; column 11, lines 1-68, particularly 52-68 and column 12, lines 1-68, particularly 39-50, which falls within the scope of the instantly claimed component (f) of claim 12; column 13, lines 1-68, particularly 30-56 which falls within the scope of the instantly claimed component d and its amount; column 14, lines 1-68; column 15, lines 1-68, particularly 32-43 which is its use as primer surfacer on plastic substrates, which encompasses the instantly claimed 13-16 since claim 16 recites no structure and thereby encompasses the substrates of the patentee which are useful in some capacity in an automotive body panel as they are assumed to be sheets, lines 44-55 of which carbon black and metallic flake pigments are the conductive pigments of the instant claim 5, and lines 65-68; column 16, lines 1-68, particularly 1-6; column 17, lines 1-68, particularly 1-10; and the remainder of the document.

It would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the instantly claimed combinations of ingredients and amounts thereof in the compositions of the patentee because they are encompassed by the patentee and would

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have been expected to give the exceptional coating properties disclosed by the patentee. It would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the instantly claimed amounts of pigment of claim 4 because the amount of pigment gives only predictable properties such as color, shade, hue etc. and is within the ability of the ordinary skilled artisan to adjust as evidenced by the patentee's lack of guidance in this regard.

Furthermore, it is expected that any choice of pigment amount would necessarily be within the instantly claimed very broad range to be useful. It would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the instantly claimed water scavenger of claim 10 because column 15, line 19 of the patentee discloses water scavengers including orthoformates, which are adjacent homologues of the instantly claimed orthoacetates, and Hazan (809) column 6, lines 43-46 show the instantly claimed orthoacetates to function as such water scavengers in similar compositions and they are therefore expected to function the same as their lower homologues in the compositions of Hazan et al..

8. Claims 1-3, 6-9, and 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 00/55229 Uhlianuk et al..

Uhlianuk discloses the instantly claimed inventions at the abstract; page 1, lines 4-38; page 2, lines 1-38, particularly 22 and 35-38 which encompasses the instant claims 2 and 3 respectively; page 4, lines 1-38; page 5, lines 1-38, particularly 8-38 which encompasses the amounts of the instantly claimed component d; page 6, lines 1-38, particularly 26-38 which falls within the scope of the amount of the instantly claimed component a and b and the molecular weights are "low molecular weights"; page 7, lines 1-38; page 8, lines 1-38, particularly 28-38; page 9, lines 1-38, particularly 1-3 and 11-19; page 10, lines 1-38, particularly 32-38 which is the instantly

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claimed component f; page 11, line 1- page 14, line 2; page 14, lines 3-38, particularly 34-38; page 16, lines 1-23 which falls within the scope of the instant claim 7 and the remainder of the document. It is not seen that the use of the reference is not a "primer surfacer" since it is used on the surface of the coated substrates therein. Furthermore, the compositions of the reference contain the instant claimed components and amounts and are therefore necessarily expected to be capable of use as "primer surfacer". Excess silane monomer that has not reacted will be the silane coupling agent since it not chemically distinct from silane coupling agents and will therefore function in the same capacity.

9. Claims 1-3 and 6-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 00/55229 Uhlianuk et al. in view of US Pat. No. 5413809 Hazan.

Uhlianuk discloses the instantly claimed inventions at the abstract; page 1, lines 4-38; page 2, lines 1-38, particularly 22 and 35-38 which encompasses the instant claims 2 and 3 respectively; page 4, lines 1-38; page 5, lines 1-38, particularly 8-38 which encompasses the amounts of the instantly claimed component d; page 6, lines 1-38, particularly 26-38 which falls within the scope of the amount of the instantly claimed component a and b and the molecular weights are "low molecular weights"; page 7, lines 1-38; page 8, lines 1-38, particularly 28-38; page 9, lines 1-38, particularly 1-3 and 11-19; page 10, lines 1-38, particularly 32-38 which is the instantly claimed component f; page 11, line 1- page 14, line 2; page 14, lines 3-38, particularly 34-38; page 16, lines 1-23 which falls within the scope of the instant claim 7 and the remainder of the document. It is not seen that the use of the reference is not a "primer surfacer" since it is used on the surface of the coated substrates therein. Furthermore, the compositions of the reference contain the instant claimed components and amounts and are therefore necessarily expected to be

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capable of use as "primer surfacer". Excess silane monomer that has not reacted will be the silane coupling agent since it not chemically distinct from silane coupling agents and will therefore function in the same capacity.

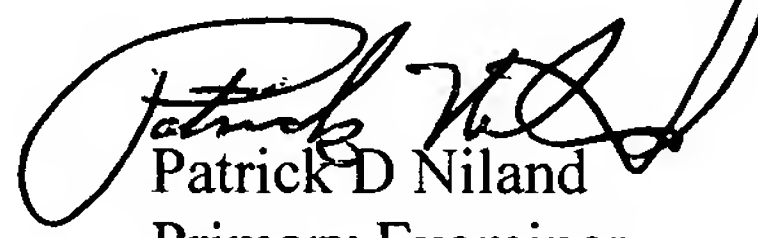
It would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the instantly claimed combinations of ingredients and amounts thereof in the compositions of the reference because they are encompassed by the reference disclosure and would have been expected to give the exceptional coating properties disclosed in the reference. It would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the instantly claimed water scavenger of claim 10 because Hazan (809) column 6, lines 43-48 show the instantly claimed orthoacetates to function as such water scavengers in similar compositions and they are therefore expected to function the same in the compositions of Uhlianuk and to give the increased pot life since there will be less water to consume reactive groups such as NCO and SiOR. It would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to coat plastic substrates with the coating compositions discussed above because Uhlianuk discloses coating automobiles (abstract et seq.), automobiles are commonly made of plastic, the coating of Uhlianuk is one that is on top of the primer and on the surface and is thus a primer surfacer and the disclosure of the reference is such that no popping nor other defects are expected since these are contrary to the properties of page 1, lines 8-22 of Uhlianuk.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Patrick D Niland
Primary Examiner
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